

REMARKS

Claims 1-38 and 43 are pending in this application.

Applicant has amended claims 1, 12-14, and 25-29. These changes do not introduce any new matter.

Applicant appreciates the courtesy extended by the Examiner during the interview conducted with Applicant's undersigned representative on July 8, 2005. Applicant concurs with the summary of the substance of the interview set forth in the Interview Summary mailed on July 13, 2005.

Applicant respectfully requests reconsideration of the rejection of claims 1, 2, 4, 9-11, 13, 14, 15, 17, and 22-28 under 35 U.S.C. § 102(e) as being anticipated by *Ogawa et al.* (U.S. Patent No. US 6,603,506 B2). As will be explained below, the *Ogawa et al.* reference does not disclose each and every feature specified in independent claims 1, 13, 14, and 25-28, as amended herein.

Applicant has amended independent claims 1, 13, 14, and 25-28 so that these claims specify the generation of a file that contains the image data and the output control data (or, where appropriate, that a means for generating a file that contains the image data and the output control data is provided). Through the use of the file containing the image data and the output control data, the claimed subject matter enables the image data to be processed at the output instead of at the image capture device as shown by *Ogawa et al.* The *Ogawa et al.* reference does not disclose each and every feature of the claims at issue for at least the reason that this reference does not disclose the generation of a file that contains the image data and the output control data (or a means for generating such a file).

Accordingly, for at least the foregoing reason, independent claims 1, 13, 14, and 25-28 are patentable under 35 U.S.C. § 102(e) over *Ogawa et al.* Claims 2, 4, and 9-11, each of which ultimately depends from claim 1, and claims 15, 17 and 22-24, each of which

ultimately depends from claim 14, are likewise patentable under 35 U.S.C. § 102(e) over *Ogawa et al.* for at least the same reasons set forth regarding the applicable independent claim.

Applicant respectfully requests reconsideration of the rejection of claims 3, 5, 6, 12, 16, 18, 19, and 29-38 under 35 U.S.C. § 103(a) as being unpatentable over *Ogawa et al.* in view of *Otake* (U.S. Publication No. US 2001/0024292 A1). The deficiencies of the *Ogawa et al.* reference relative to amended independent claim 1, from which claims 3, 5, and 6 ultimately depend, and amended independent claim 14, from which claims 16, 18, and 19 ultimately depend, are set forth above in connection with the anticipation rejection of claims 1 and 14. The *Otake* reference does not cure the above-discussed deficiencies of the *Ogawa et al.* reference relative to claims 1 and 14. Accordingly, claims 3, 5, 6, 16, 18, and 19 are patentable under 35 U.S.C. § 103(a) over the combination of *Ogawa et al.* in view of *Otake* for at least the same reasons set forth above regarding claims 1 and 14.

Regarding independent claims 12, 29, 33, 34, and 38, Applicant submits that the deficiencies of the *Ogawa et al.* reference set forth above in connection with the anticipation rejection of claims 1, 2, 4, 9-11, 13, 14, 15, 17, and 22-28 also apply to claims 12, 29, 33, 34, and 38. As noted above, the *Otake* reference does not cure the above-discussed deficiencies of *Ogawa et al.* relative to the claimed subject matter. In addition, Applicant has amended claim 12 so that this claim now specifies the generation of a file that contains the image data and the output control data. Applicant has amended claim 29 so that this claim specifies that the output control data and the image data are contained in a file. Accordingly, claims 12, 29, 33, 34, and 38 are patentable under 35 U.S.C. § 103(a) over the combination of *Ogawa et al.* in view of *Otake* for at least the same reasons set forth above in connection with the anticipation rejection.

Applicant respectfully requests reconsideration of the rejection of claims 7, 8, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Ogawa et al.* Claims 7 and 8, each of which ultimately depends from claim 1, and claims 20 and 21, each of which ultimately depends from claim 14, are patentable under 35 U.S.C. § 103(a) over *Ogawa et al.* for at least the same reasons set forth above in connection with the anticipation rejection of claims 1 and 14. In this regard, Applicant notes that the *Ogawa et al.* reference would not have suggested to one having ordinary skill in the art the subject matter defined in amended independent claims 1 and 14.

Applicant respectfully requests reconsideration of the rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over *Ogawa et al.* in view of *Inoue et al.* As will be explained below, the combination of *Ogawa et al.* in view of *Inoue et al.* would not have suggested to one having ordinary skill in the art the subject matter defined in claim 43.

Claim 43 depends from independent claim 1, which has been amended herein. The deficiencies of the *Ogawa et al.* reference relative to claim 1 are discussed above in connection with the anticipation rejection of claim 1. In addition, as acknowledged by the Examiner in the Final Office Action, the *Ogawa et al.* reference “does not explicitly disclose the printer-control information including image processing control information.” Final Office Action at page 13.

The *Inoue et al.* reference discloses a printer that reads image information and image additional information from a DSC and selects the printing control information stored in the printer in accordance with the read information. The *Inoue et al.* reference also discloses, by way of example, that the printing control information may be stored in the DSC. The *Inoue et al.* reference, however, does not disclose transmitting the printing control information itself, together with image data, to the printer. If this feature were incorporated in the *Inoue et al.* device, then it would not be necessary to store printing control information in the printer.

When the printing control information is stored in the DSC, the DSC generates only a printer-control code using the printer control information, and the *Inoue et al.* reference does not disclose the concept of transmitting printing control information to a printer. As such, the *Inoue et al.* reference would have guided one having ordinary skill in the art to modify the *Ogawa et al.* system in the manner proposed by the Examiner.

Accordingly, for at least the foregoing reasons, claim 43 is patentable under 35 U.S.C. § 103(a) over the combination of *Ogawa et al.* in view of *Inoue et al.*

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 1-38 and 43, as amended herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6902**. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP003).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.



Peter B. Martine
Reg. No. 32,043

710 Lakeway Drive, Suite 200
Sunnyvale, California 94085
(408) 749-6900
Customer Number 25920